REMARKS/ARGUMENTS

This invention provides for an efficient and economic means to differentially diagnose between prostate cancer and benign prostate hyperplasia by looking at shifts in low molecular protein markers using mass spectroscopy.

Applicants are grateful for the telephone interview of January 9, 2006, with Examiner Brandon Fetterolf. During the interview, no issues were resolved. Examiner Fetterolf did explain his remaining concerns as set forth in the pending final Office Action.

Claims 1, 8, 12, 20, and 84-88 are pending. Claims 89-94 are new. Claim 1 is amended in its preamble. No new matter has been introduced as the amendment merely restates the objective of step iv of claim 1.

New claims 89-94 correspond to pending claims 20 and 84-89 but are dependent upon claim 20 instead of claim 1.

The previously pending claims are rejected under §112 first and second paragraphs and are provisionally rejected for double patenting.

A primary concern of the Examiner concerned the preamble of claim 1. The Examiner urged that the original wording of the preamble did not accurately correlate with the final step of determining a diagnosis of prostate cancer versus benign prostate hyperplasia. As amended, applicants now submit that the preamble of claim 1 adequately restates the final step iv of the claim.

During the telephone interview, applicants' representative requested clarification over the rejection of the claims under §112, first paragraph. According to page 2 of the specification, the claims are considered enabling for samples from blood urine serum and tissue extracts but not for "a marker in any and/or all samples" (page 3 of Office Action). When asked if this was a request to incorporate the limitations of claim 8 into claim 1, the Examiner said, "no". Unfortunately, the Examiner was not able to further clarify the basis for this §112 rejection and wanted to have additional time to review that portion of the final Office Action. It was agreed that applicants would submit amendments to the preamble of claim 1 and that the

Examiner would review the §112, 1st ¶ rejection. After his review, he would either clarify the rejection or withdraw it. He further agreed to contact the undersigned attorney by telephone if the §112 rejection was suitable for addressing by an examiner's amendment. Applicants look forward to working with the Examiner to resolve this outstanding issue.

Finally, there is a provisional double patenting rejection over co-pending application No.10/221,905. Applicants acknowledge the rejection and believe that the subject application will be the first to issue. Accordingly, applicants reserve the right to file a terminal disclaimer at the appropriate time during prosecution of the '905 application. Applicants believe that no further response is required (see MPEP 804 IB "Between Copending Applications - Provisional Rejections").

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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